

**REMARKS**

Claims 1-20 and 22-35 are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration of the restriction election requirement is respectfully requested.

**The Alleged Groups**

The Action alleges that the following Groups are patentably distinct from each other:

- I.      Claims 1-17 and 22-34.
- II.     Claims 18-20 and 35.

**Applicant Provisionally Elects Group I With Traverse**

In response to the restriction election requirement, Applicant provisionally elects with traverse Group I (claims 1-17 and 22-34).

**The Requirement Is Not Legally Proper Because There Is No Serious Burden**

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a "serious burden" on the Examiner in order for restriction to be required. Conversely, if the search and examination of an entire application can be made without serious burden, then the Examiner must examine it on the merits.

First, a search and examination of the entire application has *already* occurred. Thus, there can be no serious burden on the Examiner with regard to examination. Second, the Examiner has not established serious burden based on different classification because the relied upon classifications are the same. Thus, Applicant respectfully submits that the restriction requirement is not legally proper because the criteria for serious burden has not been met by the Office.

**The Restriction Requirement Is Not Legally Proper Because It Is Not Timely**

Applicant respectfully submits that there are time limits as to when a restriction requirement can be made. MPEP § 811 indicates that an Examiner is to “make a proper requirement as early as possible in the prosecution, in the first action if possible.” 37 C.F.R. § 1.142(a) indicates that the requirement is to “be made *before* any action on the merits” and must be made “*before* final action.” Applicant respectfully submits that the restriction requirement is not in compliance with the statutes, rules, and Office procedures. The time for requiring restriction has long expired. The record shows that this application has received numerous Office actions on the merits for essentially the same recited subject matter. This application has also received a final rejection. Thus, the restriction requirement is legally improper.

Even the legal community recognizes that the pending restriction requirement is legally improper. For example, note the attached published article entitled *The “Serious Burden” Requirement Has Teeth -- A Prohibition on Restriction Requirements Later in Prosecution, Intellectual Property Today*, February 2009. The article indicates that in the USPTO, an allegation of “serious burden” cannot be relied upon by an Examiner when requiring an election involving claims which were previously twice rejected. Applicant respectfully submits that such is the current situation.

Again, the time for a restriction requirement has long passed. Thus, because the requirement is also not timely, it is further not legally proper and should be withdrawn.

**The Office has not shown the alleged Groups to be distinct**

The burden is on the Examiner to provide valid examples. If Applicant proves or provides an argument that the Examiner's suggested examples cannot be accomplished or are unreasonable, then the burden is on the Examiner to document a viable alternative or withdraw the requirement. Applicant respectfully submits that the Office has not met its required burden.

The Office alleges that Groups I and II are related as combination and subcombination. Thus, a showing of two-way distinctness is required. The Office alleges both of the criteria:

- (1) the combination (Group I) does not require the particulars of the subcombination (Group II) because Group I does *not* require "determining whether the first receipt becomes freed from the jammed condition in response to the sending of the second receipt" (step (d) of claim 18); and
- (2) the subcombination (Group II) has separate utility from Group I because it can be used where "the malfunction signal can be generated *without* both the first and second receipts being in jammed condition".

The amendment herewith further renders the Office's allegations moot. Group I (e.g., claims 14 and 31) requires the "determining whether the first receipt becomes freed" feature. Thus, the combination *includes* the particulars of the subcombination. Since the Office has not shown that the combination (Group I) does not require the particulars of the subcombination (Group II), the restriction is legally improper.

Group II (e.g., claim 18) requires determining that the second receipt is in a jammed condition in the receipt path. Thus, the subcombination (Group II) does *not* have the alleged separate utility from the combination (Group I). Since the Office has not shown that the subcombination (Group II) has separate utility from Group I, the restriction is legally improper.

The Action has not provided the required showing of distinct combination and subcombination inventions. Although a two-pronged criteria showing is required to establish (two-way) distinctness in a combination/subcombination restriction, the Office has met *neither* the first criteria nor the second criteria.

At best, the alleged Groups I and II relate as AB<sub>sp</sub>/B<sub>sp</sub>. The procedure to be followed for this relationship is set forth at MPEP § 806.05(c)(I), which states that "a requirement for restriction must *not* be made". Again, the restriction is legally improper.

**Rejoinder**

Applicant requests that the Office also consider the issue of rejoinder of claims (MPEP § 821.04). Applicant reserves all rights to rejoinder.

**The Restriction Requirement Is Without Legal Basis**

Applicant also respectfully wishes to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed, the inventions claimed must be both independent *and* distinct.

In the Action, there are only unsupported assertions that the sets of claims are "distinct." There are no assertions that the sets of claims are "independent", as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for

seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The USPTO's application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be "independent" the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not shown that the claims directed to Applicant's invention are unrelated in design, operation, and effect. Thus, the statutory requirements have not been met and no restriction requirement may be imposed.

**Conclusion**

For all the foregoing reasons it is respectfully submitted that there is no valid basis for the restriction requirement. Applicant respectfully requests that the requirement be withdrawn.

The Applicant respectfully submits that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the application at the Office's convenience.

Respectfully submitted,



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# The "Serious Burden" Requirement Has Teeth — A Prohibition on Restriction Requirements Later in Prosecution



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## BACKGROUND

For about the last decade, I have followed the strategy of appealing as soon as possible in applications for computer implemented inventions for the following reasons. First, information indicated that the policy and procedure imposed by the Director on the examining corps in this area made prosecution before the examining corps fruitless.<sup>1</sup> Second, the Board of Patent Appeals and Interferences ("BPAI") is at least nominally independent of supervision by the Director because BPAI decisions are reviewed by the Courts, not the Director. Therefore, my belief has been that a significant fraction of rejections in patent applications claiming computer implemented inventions would be reversed on appeal, leading to allowance.

Unfortunately, obtaining decisions on appeals in the computer implemented inventions area has been difficult and slow due to procedural obstacles imposed in prosecuting cases in this area. The procedural obstacles have included: examiners imposing requirements to re-file briefs to address alleged formal errors; examiners responding to appeals by reopening prosecution and imposing new grounds for rejection; and the BPAI administratively remanding cases to the examiner ordering the examiner to correct the record.<sup>2</sup>

In addition, in several cases, the examiners responded to my appeals by reopening prosecution only to the extent of imposing restriction requirements. However, the new precedent discussed below holds that requiring restriction in an application after all claims have been twice rejected is improper. Since all claims in appealed cases are normally twice rejected, the practice of responding to an appeal with a restriction requirement is generally improper and should cease.<sup>3</sup> Before discussing this precedent, it is useful to summarize the conditions required for a proper restriction.

## CONDITIONS REQUIRED FOR A PROPER RESTRICTION

The authority for the Director to require restriction appears in 35 USC 121, which authorizes the Director to impose a requirement for restriction whenever claimed inventions in one application are "independent and distinct."<sup>4</sup> The Director specifies in the MPEP instructions to examiners. These include conditions under which examiner's may require restriction.<sup>5</sup> In MPEP 803, the Director interprets 35 USC 121 to authorize restriction whenever claims in an application are independent or distinct. Various criteria are specified in the MPEP for defining inventions that are either independent or distinct from one another. The MPEP requires an examiner to specify, based upon these criteria, why the claims in an application are either independent or distinct from one another, as a necessary condition for imposing a requirement for restriction.

However, the MPEP contains an additional necessary condition that must be met by an examiner before the examiner can impose a restriction requirement. This is the requirement to show that there is a "serious burden" on the examiner to search and examine the allegedly independent or distinct claims. Specifically, the second paragraph of MPEP 803 states that:

If the search and examination of \*\*>all the claims in an< application can be made without serious burden, the examiner must examine \*>them< on the merits, even though \*\*>they include< claims to independent or distinct inventions. [MPEP 8th Edition, Rev. 5, 2006]

MPEP 803 also provides general guidance regarding what the examiner must show to satisfy the "serious burden" requirement, stating that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown \*\* by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § \*->806.04 <- § 806.04(i) and § 808.01(a).

MPEP 808.02 also discusses the "serious burden" requirement, but its discussion is redundant of MPEP 803.

Timing is also an important factor in determining whether a requirement for restriction is proper. Respecting timing for a restriction requirement, MPEP 811cites to 37 CFR 1.142(a). Rule 1.142(a) states that:

### § 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action. ... [Para (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

In discussing rule 1.142(a), MPEP 811 states that:

**811 Time for Making Requirement  
[R-3]**

37 CFR 1.142(a), second sentence, \*\*>indicates that a restriction requirement "will normally< be made before any action upon the merits; however, it may be made at any time before final action \*\*." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The rule requirement that "however, it may be made at any time before final action" clearly indicates that a requirement for restriction is improper after a final action. However, focus on the statement "as soon as the need for a proper requirement develops". That statement indicates that a requirement for restriction should be made in response to a claim amendment resulting in claims that define "independent and distinct" inventions within the meaning of 35 USC 121. MPEP 811, first paragraph, does not expressly prohibit restriction after examination of otherwise restrictable claims. However, a question arises whether there can be a "serious burden" in examination of claims already examined. The decision discussed below addresses that question.

**THERE IS NO "SERIOUS BURDEN" EXAMINING AN APPLICATION IN WHICH ALL CLAIMS WERE PREVIOUSLY TWICE REJECTED, AT LEAST IN THE EYES OF TECHNOLOGY CENTER 3600**

On 3/24/2004, I filed a petition on behalf of the applicant in application 09/478,351 that requested that a restriction requirement imposed in response to the filing of an appeal brief be withdrawn and that the appeal brief be reinstated.

decision on the petition reads in toto as follows:

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**In re Application of Michael Scroggie et al.: DECISION ON PETITION REGARDING RESTRICTION REQUIREMENT**

Applicants' petition filed on March 25, 2004 requests withdrawal of the election requirement as set forth in the Office action mailed November 24, 2003. Applicants further request reinstatement of the supplemental appeal brief filed on September 11, 2003.

The petition is GRANTED.

A review of the record reveals that the Office action mailed November 24, 2003 set forth an election requirement requiring a provisional election between five subcombinations identi-

45-49, 82, and 83; (4) Claims 3 1, 50, 51-54; and (5) Claims 55-60 and 63. Applicants elected the subcombination of Claims 28-29, 32, 73-75, 76-78, and 79-81 with traverse in the response filed December 22, 2003. The examiner, upon reconsideration, modified the grouping of the claims and mailed a non-final office action on March 1, 2004 addressing Claims 28, 29, 32, 55-60, and 73-81. The March 25, 2004 petition was then timely filed.

Applicants' petitions [sic] allege that the election requirements are improper because there would be no burden on the examiner since all of the present claims had already been rejected at least two times prior to the election requirement.

For the foregoing reasons, the examiner's provisional election requirement has been deemed to be improper.

The application is being forwarded